

Remarks

Applicants submit the following remarks in support of the patentability of the presently claimed invention over the disclosures of the references relied upon by the Examiner in rejecting the claims. Further and favorable reconsideration is respectfully requested in view of these remarks.

Initially, new claims 21 and 22 have been added to the application. These new claims are supported by the disclosures in the first and third paragraphs on page 2 of the specification.

The rejection of claims 12-15 under 35 U.S.C. §102(b) as being unpatentable over Kaule (US '221) is respectfully traversed.

One of the requirements of the presently claimed invention is that the UV-curable separation lacquer is deep-drawable. The Examiner acknowledges that the Kaule reference does not specifically teach a deep-drawable lacquer, but takes the position that the reference teaches a lacquer that is UV-curable and that the UV-curable lacquer is impressed by a mold to form features in a label, wherein the lacquer is only fully cured after an embossing step. On this basis, the Examiner takes the position that the UV-lacquer of Kaule will inherently have the deep-drawable properties as required by Applicants.

However, the fact that a certain characteristic may be present in the prior art is not sufficient to establish the inherency of that characteristic. Rather, in order to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art (MPEP 2112, Section IV). As also noted in this section of the Manual, in relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art. Applicants take the position that the Examiner has failed to establish that the deep-drawable characteristic of the lacquer employed in the present invention necessarily flows from the teachings of the Kaule reference, and for this reason alone, the rejection of the claims based on anticipation should be withdrawn.

The rejection of claims 1-8 and 16-19 under 35 U.S.C. §103(a) as being unpatentable over Kaule (WO '964/US '221) in view of Walter (US '418), or alternatively, Walter in view of Kaule, is respectfully traversed.

In connection with this rejection, the Examiner again acknowledges that the "deep-drawable" limitation of the present claims is not specifically taught by the Kaule et al. reference. Therefore, the comments set forth above concerning the rejection based on Kaule for anticipation are equally applicable to this rejection for obviousness.

The rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over Kaule in view of Walter as evidenced by Bitner et al. (US '060), as well as the rejection of claims 9 and 11 under 35 U.S.C. §103(a) as being unpatentable over Kaule in view of Walter and Zeiter et al. (US '491) are respectfully traversed.

All of claims 9-11 are dependent on claim 1, which is patentable over the references for the reasons discussed above. The Examiner applies the Bitner et al. and Zeiter et al. references for features set forth in the dependent claims. Therefore, even if the references were combined in the manner suggested by the Examiner, the result of such combination would still not suggest the subject matter of claims 9-11.

Further attention is directed to new claims 21 and 22, both of which require that the UV-curable deep-drawable separation lacquer contains two or more photoinitiators susceptible to different activation wavelengths. None of the references applied by the Examiner in rejecting the claims discloses or suggest this feature of the invention.

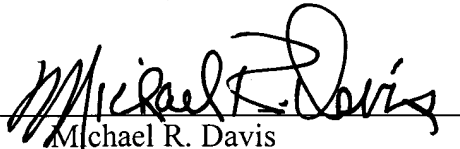
The Examiner states that Kaule teaches that the UV-curable lacquer is cured completely via two UV lamps (column 7, lines 15 -29). However, following this description the UV-lamps are positioned one outside and one inside a transparent cylinder, both focused on the same position (also see Fig. 3 (47)).

According to the present invention as set forth in claims 21 and 22, in a preferred embodiment the UV lacquer has two different photoinitiators susceptible to different activation wavelengths. Curing takes place in two different steps, i.e. precuring at the time of embossing, and final curing after embossing (see the first three paragraphs on page 2 of the specification). None of the applied references discloses or suggest this two-step curing of the UV-lacquer.

Therefore, in view of the foregoing remarks, it is submitted that each of the grounds of rejection set forth by the Examiner has been overcome, and that the application is in condition for allowance. Such allowance is solicited.

Respectfully submitted,

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